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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,033	08/22/2001	Ieyasu Kobayashi		8235

7590 07/15/2003

Rader Fishman & Grauer
1233 20th Street N W Suite 501
Washington, DC 20036

EXAMINER

RIVERA, WILLIAM ARAUZ

ART UNIT	PAPER NUMBER
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3654

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,033

Applicant(s)

KOBAYASHI ET AL.

Examiner

William A Rivera

Art Unit

3654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings are objected to because the drawings showing the film roll, i.e., the ones labeled "1. Measuring Diameters of the Film Roll", "2. Image of Shape of the Film Roll", etc. are not labeled with a numeral, such as --Figure 1--.

The examiner **MUST** approve all changes to the drawings, other than informalities noted by the Draftsperson, before the application will be allowed. Applicant is required to submit a sketch or copy of the drawings with the proposed changes highlighted in red ink in response to this Office Action. Any proposed changes to the drawings must be submitted as a separate letter to the Draftsperson. See MPEP 608.02 (r). No changes will be permitted, other than correction of informalities, unless the examiner has approved the proposed changes. However, formal correction of the noted defect(s) can be deferred until the examiner allows the application.

Specification

The disclosure is objected to because of the following informalities: there is no section with a brief description of the drawings. On page 4, line 5, is "L" the length of the rolled polyester film? It appears that it would be more accurate to state that --L is the length of the rolled film

Appropriate correction is required.

Claim Objections

Claim 1 is objected to because of the following informalities: Is "L" the length of the rolled polyester film? It appears that it would be more accurate to state that --L is the length of the rolled film. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 is vague and indefinite. On line 3, the phrase “ given that a curved line...among one end of diameter lines” is unclear. How is a curved line having two ends formed among one end of diameter lines? On line 7, what constitutes a convex portion side or a concave portion side? How does one know how to treat it element as a concave or convex portion?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Sasaki et al (U.S. Patent No. 4,576,344).

With respect to Claims 1-3 and 16-18, note that Sasaki et al teach a polyester film roll free from wrinkles. Therefore, the minimum diameter value is not more than $2W \times 10^{-3}$ because the width of the roll is uniform throughout the roll and such is the case for the condition $L \times 10^{-7}$.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3654

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-15 and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al as applied to claims 1-2 and 16-17 above.

Sasaki et al do not mention the specific dimensions in term of rolling hardness or flexural modulus etc. However, it would have been an obvious matter of design choice, as determined through routine experimentation and optimization, to dimension the polyester film roll of Sasaki et al as specified in Claims 4-15 and 19-24 because one of ordinary skill would have been expected to have routinely experimented to determine the optimum dimensions for a particular use.

Response to Arguments

The new grounds of rejection were necessitated by applicant's amendment, e.g., the requirement for the measurement of the roll along the width direction of the roll, Claim 1, lines 2-3; the requirement for a curved line having two end can be formed from among one end of diameter lines, Claim 16, lines 2-3.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

Art Unit: 3654

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

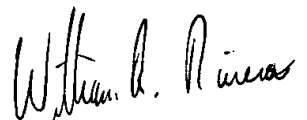
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William A. Rivera whose telephone number is (703) 308-2684. The examiner can normally be reached Monday through Friday from 2:00 PM to 10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki, can be reached on (703) 308-2688.

Telephone status inquiries regarding this application should be directed to (703) 308-1113. **Facsimile correspondence** for this application should be sent to the following respective numbers:

For **BEFORE FINAL** correspondence: (703) 872-9326

For **AFTER FINAL** correspondence: (703) 872-9327



**WILLIAM A. RIVERA
PRIMARY EXAMINER**

July 14, 2003

Art Unit: 3654

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**WILLIAM A. RIVERA
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July 14, 2003